REMARKS

Claims 1, 12 and 22 have been amended. Claims 1-20 and 22 are pending in the present application. Applicant reserves the right to pursue the original claims and other claims in this application and in other applications.

Claims 1-20 and 22 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. According to the Office Action, the claims recite "subsequent" worker assignments without also claiming initial assignments. Office Action at page 2. The rejection is respectfully traversed.

Claims 1, 12 and 22 have been amended to address the concerns raised in the Office Action. Applicant respectfully submits, however, that claim 8, which contains different limitations, already recited worker assignments prior to the recitation of "subsequent" worker assignments. Accordingly, a change to claim 8 was not required. Applicant respectfully submits that the rejection should be withdrawn and the claims allowed.

Claims 1-4, 6-14 and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Miller (U.S. Patent no. 7,035,809). The rejection is respectfully traversed.

Claim 1 recites a method for creating a workflow process management application suitable for an organization. According to claim 1, the "workflow process management application, when executed by said computer, permits a user to: enter, for each department, a workflow plan for said department, generate worker assignments, receive a workflow performed by departments of said organization, and create a report comparing said workflow plan with said workflow performed." Claim 1 further recites that "said workflow process management application [uses] said report to automatically generate subsequent worker assignments without further interaction

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with the user." Applicant respectfully submits that Miller fails to disclose, teach or suggest the claim 1 invention.

Miller by contrast is directed to a "method for assisting and expediting an organization's progression through the levels of the Capability Maturity Model (CMM). Specifically, the [Miller] invention relates to a method and related system for arranging and administering an organization's infrastructure and a project of interest so that the organization and the product may be more mature, as measured by the CMM." Miller Col. 1, ll. 6-12. Miller is designed to produce an organization plan 1140 (Miller FIG. 11A). This is entirely different than the claimed invention's workflow, which refers to both work (i.e., activities) that must be performed as well as the resources required to perform the work. This is one reason why the claimed invention is patentable over Miller.

Moreover, the entirety of the Miller reference relates to multiple process steps and flowcharts designed at meeting the CMM goal. Almost all of these processes require offline managerial and/or other forms of external review. See e.g., Miller Col. 7, l. 56 to Col. 8, l. 1 (project management is expected to take appropriate action); Col. 8, ll. 32-48 (the "implementing organization may further obtain approval for corrective actions, and then take corrective actions"); Col. 8, l. 58 to Col. 9, 2 ("Another scope management task is requirements acceptance, during which the organization documents and reviews requirements with all affected groups and obtains acceptance from the affected stakeholders."); Col. 10, l. 46 to Col. 11, l. 18 (listing multiple issues to be referred to program/senior management for handling/correcting).

In addition, according to a portion of Miller relied upon by the Office Action as teaching the limitation "using said report to automatically generate subsequent worker assignments," Miller states:

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> During the control of SEPG project work in the step 230,
> SEPG project management monitors the execution of the
> project against project plan and makes adjustments as
> necessary. Project Status Reports are prepared for the
> Project Sponsor. Potential and actual problems are
> identified through the measuring and monitoring of
> progress and performance against the SEPG Project Plan.
> Depending on the type of problem identified, an Issue, Risk,
> System Investigation Request (SIR) or Change Request (CR)
> is logged. The SIRs and the CRs are described in greater
> detail below. SEPG Project management is expected to take
> appropriate corrective actions to resolve problems that are
> discovered.
> Miller Col. 7, l. 56 to Col. 8, l. 1 (emphasis added).

Accordingly, it is clear from the description throughout the Miller reference, there is no capability in Miller for, or disclosure of, a "workflow process management application using said report to automatically generate subsequent worker assignments without further interaction with the user." The actions by project management cannot be deemed to be automatic and without user interaction.

The Office Action, however, now appears to rely on the following reference in Miller to "Microsoft Project" as disclosing the automatic generation of subsequent worker assignments:

> In the development of subordinate plans, step 216, the
> organization may further create a work plan. For instance,
> the organization may create a "bottom up" or task-level
> project work plan based upon estimates where critical paths
> and dependencies are defined and managed within a project
> work-planning tool, such as Microsoft Project and Project
> Workbench®.
> Miller Col. 6, ll. 15-21.

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Without any support whatsoever, the Office Action makes general statements about dependent child tasks being automatically changed based on Miller's citation to Microsoft Project. Applicant respectfully traverses this argument. Miller has disclosed no features from Microsoft Project that relate to the claimed invention. Nor has the Office Action shown how the claimed invention is disclosed in Miller. The claimed invention requires the generation of worker assignments, receipt of workflow performed by departments of the organization, and the creation of a report comparing the workflow plan with the actual workflow performed. Then, the "workflow process management application [uses] said report to <u>automatically</u> generate subsequent worker assignments <u>without further interaction with the user</u>." Nothing in Miller or in Microsoft Project discloses these limitations. Moreover, the Office Action has not cited to any information that illustrates what the capabilities of Microsoft Project were in 2001, when the Miller patent application was filed. In fact, the implication that Miller generates subsequent worker assignments without user interaction completely goes against all of the Miller disclosure, which specifically relies on management and user intervention to "take appropriate actions." Miller Col. 7, l. 56 to Col. 8, l. 1. As such, there can be no disclosure of the claimed invention in Miller, even if combined with Microsoft Project.

As also stated in an earlier amendment, Applicant acknowledges that Miller does disclose a computer implementation whereby a computer application:

> <u>prompts</u> an organization for various inputs regarding its
> operation and structure. Using these inputs, the application
> then creates a series of task lists to implement the APIF
> method 10 of the present invention. The application may
> further create a record of task lists, so that the organization
> may easily document its actions as required in the CMM
> and CMMI. Alternatively, the program may provide
> templates through which the organization may document its

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activities.
Miller Col. 59, ll. 37-46 (underline added).

Applicant respectfully submits that templates and task lists are not automatic features allowing the computerized implementation of Miller's methods to generate subsequent worker assignments automatically based on a report and without user interaction. This portion of Miller specifically states that the organization is prompted for information. Miller's Figure 11A is described as a computer application of the Miller processes and flowchart steps. According to Miller, the FIG. 11A system 1100 is capable of receiving a user input 1130 and producing a business organization plan 1140 based on the user input 1130. Nowhere in this portion of Miller, or in any of the portions relied on in the Office Action, is there a disclosure of a "workflow process management application using said report to automatically generate subsequent worker assignments without further interaction with the user." As such, Applicant respectfully submits that the claimed invention is allowable over Miller.

Claims 2-4 and 6-7 depend from claim 1 and are allowable along with claim 1. Claim 8 similarly recites that "said workflow process management application uses said report to automatically generate subsequent worker assignments without further interaction with the user." Accordingly, claim 8 is allowable over Miller for at least the reasons set forth above and on its own merits. Claims 9-11 depend from claim 8 and are allowable along with claim 8.

Claim 12 similarly recites that "said workflow process management application uses said second report to automatically generate subsequent worker assignments without further interaction with the user." Accordingly, claim 12 is allowable over Miller for at least the reasons set forth above and on its own merits.

Claims 13-14 depend from claim 12 and are allowable along with claim 12. Likewise, claim 22 recites the act of "automatically generating subsequent worker assignments without further interaction with the user based on information in the second report." As such, claim 22 is also allowable over Miller.

Applicant respectfully submits that the rejection should be withdrawn and the claims allowed.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller. The rejection is respectfully traversed. Claim 5 depends from claim 1, which as set forth above, is allowable over Miller. Applicant respectfully submits that claim 5 is allowable along with claim 1 and that the rejection should be withdrawn and claim 5 allowed.

Claims 15-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Flores (U.S. Patent no. 5,734,837). The rejection is respectfully traversed.

Claims 15-20 depend from claim 1, which as set forth above, is allowable over Miller. Applicant also submits, however, that Flores, which has been cited as allegedly teaching specific features missing from Miller (e.g., displaying a page in a user interface, creating objects based on user events, etc.), does not rectify the above-noted deficiencies of Miller. For example, and as successfully argued in a prior amendment, Flores fails to disclose, teach or suggest a "workflow process management application, when executed by [a] computer, permits a user to: . . . create a report comparing said workflow plan with said workflow performed; [where] said workflow process management application [uses] said report to automatically generate subsequent worker assignments without further interaction with the user."

Flores, by contrast, merely discloses observing the status of a transaction via status reports. Flores does not elaborate what these status reports contain. Flores does not disclose or suggest the ability to "create a report comparing said workflow plan with said workflow performed" or the ability for the <u>application</u> to use the "report to automatically generate subsequent worker assignments without further interaction with the user." As such, Flores fails to disclose, teach or suggest this feature, which is also missing from Miller. Accordingly, the claims are allowable over the cited combination for at least this reason.

Moreover, as argued before, Applicant respectfully submits that Flores fails to teach or suggest how to modify Miller to obtain the claimed invention. This argument seems to be ignored by the Office Action. Absent a motivation within the references themselves to modify the references, there can be no *prima facie* case of obviousness. Obviousness is based on factual findings. "Whether a patent claim is obvious under section 103 depends upon the answer to several factual questions and how the factual answers meld into the legal conclusion of obviousness *vel non.*" *McGinley v. Franklin Sports, Inc.,* 262 F.3d 1339, 1351 (Fed. Cir. 2001). The four underlying factual inquiries are: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of non-obviousness. *Graham v. John Deere Co.,* 393 U.S. 1, 17-18 (1966).

Applicant respectfully submits that there is no motivation to combine the cited references to obtain the invention of claims 15-20. Motivation or suggestion to combine or modify prior art references "must be clear and particular, and it must be supported by actual evidence." *Teleflex, Inc. v. Ficosa North America Corp.,* 299 F.3d 1313, 1334 (Fed. Cir. 2002). Because the "genius of invention is often a combination of known elements which in hindsight seems preordained," the Federal Circuit requires a

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"rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *McGinley*, 262, F.3d at 1351. Yet there is no teaching or suggestion within any of the references that provide a motivation to combine them.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Thus, a showing of an obvious combination requires more than just an amalgam of references, each of which provides one feature of the claimed invention.
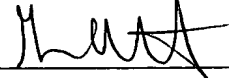
The Office Action has done no more than cite a pair of references, each of which allegedly provides only part of the claimed invention, and allege that their combination renders the invention obvious. However, without the benefit of hindsight, there would have been no motivation to combine these references and the Office Action has failed to provide proof of any such motivation. This is one more reason why claims 15-20 are allowable over the cited combination.

Applicant respectfully submits that the rejection should be withdrawn and the claims allowed.

In view of the above, Applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

By _____

Thomas J. D'Amico
   Registration No.: 28,371
Gianni Minutoli
   Registration No.: 41,198
DICKSTEIN SHAPIRO LLP
1825 Eye Street, NW
Washington, DC 20006-5403
(202) 420-2200
Attorneys for Applicant

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